

Appl. Serial No.: 09/885,721
Amdt. dated 14 September 2006
Reply to Office Action of 14 June 2006

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REMARKS

As noted previously, Applicants appreciate the Examiner's thorough examination of the subject application.

Claims 1, 6-8, and 52-54 are currently pending in the application. In the Office Action mailed 31 October 2005, claims 1, 6-8, 12, 13, 51-54 were rejected, as described in further detail below. Independent claims 1 and 11 have been amended herein. Claims 2-5 and 9-51 have been canceled. Claims 1, 6-8, and 52-54 have been amended by the present amendment. No new matter has been added. Applicants request reconsideration and further examination based on the foregoing amendments to claims and the following remarks.

Claim Rejections – 35 U.S.C. § 102

In the Office Action of 14 June 2006, claims 1, 6-8, 12, 13, and 51-54 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by JP 409067245 (e.g., Abstract) (JP '245). Claims 1, 6-8, 12, 13, and 52-54 were further rejected under 35 U.S.C. § 102(b or e) as being anticipated by U.S. Patent Application Publication No. 2003/0077313 to Schwartz et al. (Schwartz) or U.S. Patent No. 5,641,517 to Eskeland et al. (Eskeland). Claims 1, 6, 7, 12, 13, and 52-54 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,447,762 to Francesco Casado Galcera (Casado Galcera). Claims 1, 6, 8, 12, 13, and 51-54 were additionally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,170,638 to Oswades et al. (Oswades). Claims 1, 6-8, 12, 13, 51, 52, and 54 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Journal of Fertilizer, Feeding Stuffs and Farm Supplies, 11, 694 (1926) by W. L. Davies (Davies). Applicants traverse the rejections for the following reasons.

Claim 1 as amended, representative of the independent claims of the subject application, recites the following:

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A composition comprising a pharmaceutical grade extract of hops comprising an effective amount of tetrahydroisohumulone, and an effective amount of at least one component selected from the group consisting of essential oils, fats and waxes, wherein said pharmaceutical grade extract provides about 0.01 to 100 mg per kg of body weight per day of tetrahydroisohumulone.

[Emphasis added]

One requirement for a rejection under 35 U.S.C. § 102 is that the cited reference teach each and every limitation as arranged in the claims at issue. In the situation none of the cited references teaches (or suggests) the limitations as arranged in independent claims 1 and 52 as amended, e.g., limitations including a “pharmaceutical grade extract of hops comprising an effective amount of tetrahydroisohumulone” and “wherein said pharmaceutical grade extract provides about 0.01 to 100 mg per kg of body weight per day of tetrahydroisohumulone.” Because each of the cited references fails to teach (or suggest) the limitations of independent claims 1 and 52 as amended, the rejections of claims 1, 6-8, 12, 13, and 51-54 under 35 U.S.C. § 102 are without proper basis and should be withdrawn accordingly.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1, 6-8, 12, 13, and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over Davies, Eskeland, Schwartz, Casado Galcera, or Oswades, taken with JP ‘245. Applicants traverse the rejection for the following reasons.

One necessary requirement to establish a *prima facie* case of obviousness for a rejection under 35 U.S.C. § 103(a), is that the cited reference(s) must teach or suggest all of the limitations as arranged in the rejected claim(s). In this situation, the combination of Davies, U.S. Patent No. 5,641,517 to Eskeland et al. (Eskeland), Schwartz, Casado Galcera, or Oswades, taken with JP ‘245, fails to teach or suggest all of the limitations as arranged in claims 1, 6-8, and 52-54. As noted previously for the arguments against the rejections under 35 U.S.C. § 102, none of the cited

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references individually or collectively teach or suggest the limitations recited in amended independent claims 1 and 52, e.g., including a "pharmaceutical grade extract of hops comprising an effective amount of tetrahydroisohumulone" and "wherein said pharmaceutical grade extract provides about 0.01 to 100 mg per kg of body weight per day of tetrahydroisohumulone."

Accordingly, the rejection of claims 1, 6-8, 12, 13, and 51-54 under 35 U.S.C. 103(a) is without proper basis and should be withdrawn accordingly.

Conclusion

Applicants believe that all claims pending in the application are in condition for allowance and respectfully request a timely Notice of Allowance for the application. If a telephone conference will expedite prosecution of the application the Examiner is invited to telephone the undersigned. Authorization is hereby given to charge our deposit account no. 50-1133 for any fees required for the prosecution of the subject application.

Respectfully submitted,

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